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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/062, 255	04/17/98	MARAVETZ	P B0932/7088RF

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EXAMINER

VANAMAN, F

ART UNIT	PAPER NUMBER
3611	21

DATE MAILED: 02/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>09/062,255</b>	Applicant(s) <b>Maravetz et al.</b>
	Examiner <b>Frank Vanaman</b>	Group Art Unit <b>3611</b>

Responsive to communication(s) filed on Nov 17, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- Claim(s) 1-28, 30-43, and 45-78 is/are pending in the application.
- Of the above, claim(s) 78 is/are withdrawn from consideration.
- Claim(s) 24, 33-43, 45-50, and 73 is/are allowed.
- Claim(s) 1-23, 25-28, 30-32, 51-72, and 74-77 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \*Certified copies not received: \_\_\_\_\_
- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **Status of Application**

1. Applicant's amendment, filed Nov. 17, 2000 has been entered in the application. Claims 1-28, 30-43, and 45-78 are pending, claim 29 having been canceled.

### **Election/Restriction**

2. Claim 78 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 12.

Claim 78 has been withdrawn from consideration in view of applicant's amendment of Nov. 17, 2000 which refers to the limitations of claim 78 as being shown in the embodiment of figures 3-23, a non-elected species (see applicant's remarks, page 6). The species elected by applicant was species II, as shown in figures 24-31.

Applicant is reminded of the necessity of identifying the species to which a claim is directed as set forth in the restriction requirement: "Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added."

### **Claim Rejections - 35 USC § 112**

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-23, 25-28, 30-32, 51-72 and 74-77 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

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application was filed, had possession of the claimed invention. In claim 1, lines 4 and 16-17; claim 51, lines 13-14; claim 53, lines 1-2; claim 54, lines 1 and 8-9 and claim 74, lines 3-4 the recitations directed to the prevention of release are not supported by the specification as filed. Applicant has previously referred to page 38, line 30, as providing support for this limitation, however the specification indicates that a resisting of release is provided, and not a prevention. Further note, for example, page 38, lines 24-28 or page 37, lines 2-4, wherein a releasing action is clearly described, in contradiction with the material added to the claims.

5. Claims 1-23, 25-28, 30-32, 51-72 and 74-77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 4 and 16-19, claim 51, lines 13-18, claim 54, lines 8-13 and claim 74, lines 3-5 and 9-10, the recitations of a binding system which prevents release of one element from another, followed directly by a recitation describing the release of one element from another is contradictory.

In claims 51-53, the scope is unclear in claim 51, lines 16-18, claim 52, lines 1-3 and claim 53, lines 1-2, while the preambles to the claims are directed to a snowboard boot suggesting a subcombination, the positive relationship recited between the two engagement members, one on the boot and one on the binding suggests a combination.

#### **Claim Rejections - 35 USC § 102**

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-5, 7-12, 15, 27, 30-32, 51-58, 64, 68 and 74-76 as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Bader et al. (DE 4,020,873). Bader et al. teach a binding system for attaching a boot (3) having a sole (10-- upper elements 4) to a gliding board

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(1-- lower elements 2) with a mating engagement system located at least under a toe region (figs. 1, 2) comprising upper wedge-shaped cleat elements (figs. 14, 15 for example), symmetrical about a longitudinal axis, and having narrow free ends and wide base ends, the region between the base and the base end of the wedge (e.g., upper elements, fig 15) providing a shelf which serves to engage a pair of lower mating engaging elements (lower elements, figure 15) and do not allow vertical disengagement of the boot from the binding in response to forces below a threshold which overcomes the engagement between the elements, the narrow ends of the wedges being narrower than the spacing between the lower elements so as to allow a vertically downward insertion of the boot in the binding, the engaging causing a deformation of both the lower mating elements and upper wedge elements from an undeformed, closed, position associated with the boot being disengaged from the binding to a deformed, open, position associated with the insertion of the boot in the binding, and returning to an undeformed position (a) upon seating of the boot in the binding, or (b) subsequent removal of the boot from the binding, as broadly claimed. Bader et al. further teach a connection which employs both deformation and camming action (e.g., fig. 14) which can be used to facilitate the mutual deformation of the engaging elements (31) to the same degree during both insertion and removal of the boot from the binding.

#### **Claim Rejections - 35 USC § 103**

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
9. Claim 77 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bader et al. The reference of Bader et al. is discussed in detail above, and fails to teach the removal of the boot as comprising a step of lifting a heel area followed by pivoting about a toe area, however the structure of the reference of Bader et al. would allow such a motion, e.g., a removal of the rear portion first, the pivoting resulting in that a forward foot portion remains temporarily anchored to

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the board, and it would be obvious to perform such a step, for example should a rider's balance be upset, resulting in a forward pitching.

### Response to Arguments

10. Applicant's comments directed to the rejections under 35 USC §112, first paragraph, to the limitations of the bindings as being non-releasable are noted, but are not persuasive. Applicant is again directed to the sections of the specification which clearly disclose that the binding may be released (e.g., page 38, lines 24-28 or page 37, lines 2-4) by the user, wherein a releasing action is clearly described, in contradiction with the material added to the claims. A "non-releasable binding" would not be capable of releasing as is clear from the term "non releasable". Note that a non-releasable binding is not the same as a --non-self-releasing binding--, which term would be considered more appropriate in defining applicant's invention.

As regards applicant's comments directed to the amended claims 45, 46, and 48, the examiner agrees, and the rejections associated with specific issues in these claims have been withdrawn.

As regards applicant's arguments directed to claims 51-53, the examiner notes the amendments to claim 51, but further notes that claim 51, lines 16-18 retains a positive recitation which suggests a combination, as does claim 52, lines 1-3 and claim 53, lines 1-3.

In response to applicant's argument that the reference to Bader fails to show certain features of applicant's invention, it is noted that the features upon which applicant has based the comments and remarks (i.e., a particular amount of force required to release a boot from the binding) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the inventive binding would be 'non-releasable during riding' in contrast to the Bader reference, please note that a recitation of the intended use

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of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Note that the binding taught by Bader is designed to attach a user's boot to a gliding board, and thus would be 'non-releasable during riding' as broadly recited by applicant, unless the rider instigates a release. Note Bader's figure, 15, for example, which includes a structure which does not allow the release of the boot from the binding unless a substantially high threshold force is achieved. The binding may release if sufficient force is applied, but such an application of force would not occur during riding, for example, but during a fall. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

### **Allowable Subject Matter**

### **Claims Not Rejected on Prior Art**

11. Claims 24, 33-43, 45-50 and 73 are allowed.
12. Claims 6, 13, 14, 16-23, 25, 26, 28, 59-63, and 65-72 have not been rejected as unpatentable over the prior art of record, however these claims are rejected under 35 USC §112, first and second paragraphs, and would not be allowable until the resolution of all first and second paragraph issues set forth in this office action.
13. Applicant is reminded that claim 78 has been withdrawn from consideration as being drawn to the species of figures 3-23, the elected species being that associated with figures 24-31.

### **Conclusion**

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Vanaman whose telephone number is (703) 308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

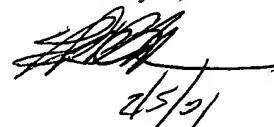
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or faxed to :

(703) 305-3597 or 305-7687 (for formal communications intended for entry;  
informal or draft communications may be faxed to the same number but should be  
clearly labeled "UNOFFICIAL" or "DRAFT")

FRANK B. VANAMAN  
Patent Examiner  
Art Unit 3611

February 5, 2001

  
2/5/01